



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

SW

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/928,682 | 08/13/2001 | Ted L. Beaver | 09798495-0034 | 8173 |

26263 7590 11/04/2004

SONNENSCHN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

| |
|----------|
| EXAMINER |
|----------|

CASTELLANO, STEPHEN J

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3727

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,682

Applicant(s)

BEAVER, TED L.

Examiner

Stephen J. Castellano

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3727

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 states that the second container portion doesn't have a shoulder or neck at the top of the second container portion. This was never stated in the written specification or claims of the originally filed application. The drawings disclose that the second container portion has a neck insofar as the top open end edge terminates with an upwardly extending vertical wall that forms a neck as reinforcement 40 forms a groove in the exterior wall, the bottom portion of the groove forms the shoulder. Also, the definition of neck has been provided in an Appendix. Definition 4 states "a relatively narrow elongation, projection, or connecting part." Insofar as portion 28 is narrower than main portion 12, the second portion is considered a neck. Insofar as the top of the second portion is a relatively narrow elongation, projection or connecting part, the second portion has a neck and a shoulder. There are four reinforcements at the top of the second container portion. Claim 15 is similar. **This is a new matter rejection.**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites the limitation "the connecting portion" in lines 8 and 9. There is insufficient antecedent basis for this limitation in the claim at this point in the claim.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8 and 11-16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Blecher.

Blecher discloses a first container portion (body 12), a second container portion (tubular body 26), the second container portion is fixedly connected to the first container portion solely along a length of a single side of the second container portion by the connecting portion (flexible strap type hinge 22 and a detent projection on the inner surface of the hinge 22). The detent projection rests against the outer wall of body 12 to push the wall upwardly into contact with a groove on the underside of the tubular body 26.

Claims 1-4, 12-15 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rosenblatt.

Rosenblatt discloses a first container portion (in Fig. 4, the portion of the cylindrical sidewall of container 12 which is on the extreme left side and covering only 1% of the cylindrical sidewall, this portion is a slim section extending from the top to the bottom of the

Art Unit: 3727

cylindrical sidewall), a second container portion (in Fig. 4, a second portion of the cylindrical sidewall of container 12 which is on the extreme right side and covering only 1% of the cylindrical sidewall, this second portion is a slim section extending from the top to the bottom of the cylindrical sidewall), the first and second portions do not touch partition 30, a connecting portion includes partition 30 and the remaining 98% of the cylindrical sidewall. A similar reasoning can be applied to the other embodiments of Rosenblatt to explain how they read on the claims. Note that “container portion” is broad enough to read on a slim section of an enclosing wall and is not required to enclose or encircle a volume. The second container portion being fixedly connected to the first container portion solely along a length of a single side of the second container portion by the connecting portion.

Rosenblatt can be read such that the partition 30 in Fig. 4 provides complete separation between first and second wall portions of cylindrical wall 12, the partition extends between the two wall portions and the partition includes two exterior portions which are adjacent to and touch both the first and second wall portions. The second container portion being fixedly connected to the first container portion solely along a length of a single side of the second portion by the connecting portion.

Claims 1-3, 5, 6, 11-13 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Levy et al. (Levy).

Levy discloses a perfume bottle container comprising a first portion (outer portion) with a shoulder and neck at the top when rotated 90 degrees clockwise from the orientation shown on the front page, a second portion (inner portion)(there is no shoulder or neck at the top of the second portion) and a connecting portion (horizontal wall connecting first and second portion).

Art Unit: 3727

The second container portion being fixedly connected to the first container portion solely along a length of a single side (bottom side) of the second portion by the connecting portion.

Claims 1-3, 5-7, 9, 12-15 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Chang.

Chang can be read such that the partition 18 in Fig. 2 provides complete separation between first and second wall portions of cylindrical wall 12, the partition extends between the two wall portions and the partition includes two exterior portions which are adjacent to and touch both the first and second wall portions. The second container portion being fixedly connected to the first container portion solely along a length of a single side (bottom or top side) of the second portion by the connecting portion.

The other embodiments of Chang also read on the claims as the co-molded limitation doesn't preclude co-molding of separate pieces. The invention may be one-piece but this is never stated in the claims.

Claims 1, 3, 5, 6, 11 and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Mayer.

Mayer can be read such that the partition 78-82 in Fig. 5 provides complete separation between first and second wall portions of cylindrical wall, the partition extends between the two wall portions and the partition includes two exterior portions which are adjacent to and touch both the first and second wall portions. The second container portion being fixedly connected to the first container portion solely along a length of a single side (bottom or top side) of the second portion by the connecting portion.

Art Unit: 3727

Claims 1, 4-6 and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Grady.

Grady can be read such that the partition or shared wall in Fig. 2 and 3 provides complete separation between first and second wall portions, the partition extends between the two wall portions and the partition includes two exterior portions which are adjacent to and touch both the first and second wall portions. The second container portion being fixedly connected to the first container portion solely along a length of a single side of the second portion by the connecting portion.

Claims 1, 4-6 and 11-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cambio, Jr. (Cambio).

Cambio discloses a similar construction wherein the conduit 12 (second portion) is connected to the main container body (first portion) by a connecting portion which extends outwardly from both the first and second portions, the second container portion being fixedly connected to the first container portion solely along a length of a single side of the second container portion by the connecting portion. Although Cambio states “neck 13” it is noted that the neck doesn’t have any grooves or inward indentations and the threads provided are exterior threads.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiemann in view of Grady and Cambio.

Schiemann discloses a first container portion 12, a second container portion 13 and a connecting portion 18. Schiemann discloses the invention except for the absence of a neck or shoulder on the top of the second portion. Grady teaches a first portion 101 and a second portion 114 with no shoulder or neck with a cylindrical portion which is similarly constructed as the top of the second portion of the invention. It would have been obvious to modify Schiemann to include another compartment or to modify the second compartment to be a tool compartment as motivated by the Schiemann teaching of storing tools. This modified or additional compartment would have no shoulder or no neck as the teachings of Grady provide that tool storage without neck or shoulder.

The second container portion being fixedly connected to the first container portion solely along a length of a single side of the second container portion by the connecting portion.

Re claims 2 and 3, Cambio shows the inwardly directed depressions.

Applicant's arguments filed August 24, 2004 have been fully considered but they are not persuasive.

Applicant has not considered the breadth of the term "container portion" to encompass a part of a container that doesn't encircle or enclose. Applicant has not interpreted the references to encompass separating walls which separate two portions of a container's exterior so that a second container portion is fixedly connected to a first container portion solely along a length of a single side of the second container portion by the connecting portion.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Castellano whose telephone number is 703-308-1035. The examiner can normally be reached on M-Th 6:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3727

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Stephen J. Castellano
Primary Examiner
Art Unit 3727

sjc